

REMARKS

The Office Action has been carefully considered and the foregoing amendment made in response thereto. Before entry of this paper, the status of the application is as follows:

- Claims 1, 4-23, 26-31, and 35-39 are pending in the application.
- Claims 26-29 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Okajima (U.S. Pat. No. 5,850,702).
- Claims 1, 4-9, 19-21, 26-29, and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tong (U.S. Pat. No. 5,185,943).
- Claims 26 and 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trolle (U.S. Pat. No. 1,141,889).
- Claims 1, 4, 6-10, and 19-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lorenzi et al. (U.S. Pat. No. 1,684,676).
- Claims 1, 5, 6, 8-10, 12-23, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917).
- Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Kendall (U.S. Pat. No. 5,713,143).
- Claims 26-30 and 35-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Crowley (U.S. Pat. No. 4,393,604).
- Claims 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Crowley (U.S. Pat. No. 4,393,604), and further in view of Cameron (U.S. Pat. No. 3,739,497) or Barre (U.S. Pat. No. 5,473,827).

In view of the above amendment and following remarks, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 4-23, 26-31, and 35-39.

1. Applicant thanks the Examiner for approving the proposed drawing corrections submitted on September 30, 2002. As requested in the instant Office Action, Applicant has enclosed herewith a complete set (thirteen sheets) of corrected, formal drawings.

2. Claims 26-29 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Okajima (U.S. Pat. No. 5,850,702). Applicant respectfully traverses this rejection as applied to the claims as amended.

Okajima discloses a snowboard boot sole having a sole core member 1 that is divided into left 1L, middle 1M, and right 1R portions. Col. 4, ll. 33-36. As depicted in Okajima Figure 7, there are linear spaces extending the length of the sole between the middle 1M and left 1L portions, and between the middle 1M and right 1R portions (near reference designators 6R and 6L, respectively). A cleat is also attached to the middle portion 1M. Col. 4, ll. 13-16.

Applicant has amended independent claim 26 to include language locating the claimed cleat proximate to at least one of the lateral and medial sides of the article of footwear. No new matter has been added, since support for this configuration is disclosed in the Specification at, for example, p. 10, ll. 19-20. Further, Figure 3A depicts cleats 232, 234 proximate to the sides of the article of footwear.

Applicant has also amended independent claim 39 to clarify the geometry of the spaces between the elongated elements that comprise the claimed chassis. Specifically, Applicant has added language to claim 39 to indicate that these spaces are generally nonlinear. No new matter has been added, since support for this characteristic of the spaces is disclosed in, for example, Figure 4 and at p. 6, l. 13 of the Specification.

Applicant respectfully submits that Okajima does not anticipate Applicant's claimed invention. Anticipation requires the disclosure in a single reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Applicant has amended independent claims 26 and 39 to include additional attributes of the claimed invention. Okajima neither discloses nor suggests placement of a cleat proximate to at least one of the lateral and medial sides of the article of footwear. Further, Okajima neither discloses nor suggests generally nonlinear spaces between the middle 1M and left 1L portions, and between the middle 1M and right 1R portions, of the sole core member 1.

Accordingly, Applicant respectfully submits that independent claims 26 and 39, as amended herein, are clearly and patentably distinguished over Okajima and are, therefore, allowable. As claims 27-29 depend from claim 26, Applicant submits that these claims are allowable as well.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 26-29 and 39 under 35 U.S.C. § 102(b) as being anticipated by Okajima.

3. Claims 1, 4-9, 19-21, 26-29, and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tong (U.S. Pat. No. 5,185,943). Applicant respectfully traverses this rejection as applied to the claims as amended.

Tong discloses an insert member for a sole 24. The sole 24 includes an outsole 26 that, in the heel region 30, includes downwardly extending lugs 32-46. Col. 5, ll. 8-10. The insert member includes extensions 60-72 in positions that correspond to those of the lugs 32-46. Col. 7, ll. 44-47. Tong Figure 16, referenced in the instant Office Action, is a plan view of the insert member 120. Figure 17 provides a side view of the insert member 120 depicted in Figure 16. As clearly shown in Figure 17, the insert member 120 is not planar. Further, Tong describes a preferred embodiment wherein the extending portion 124 of the insert member 120 has “an undulating or sinusoidal shape in cross section.” Col. 9, ll. 27-29.

Applicant respectfully submits that Tong does not anticipate Applicant’s claimed invention. Anticipation requires the disclosure in a single reference of each element of the claim under consideration. *W.L. Gore & Assocs.*, 220 USPQ at 313. Applicant’s independent claims 1, 20, and, as amended herein, 26 are directed to a generally planar chassis. This generally planar characteristic stands in contrast to the “undulating or sinusoidal” cross-sectional geometry of the insert member that Tong discloses.

Accordingly, Applicant respectfully submits that independent claims 1, 20, and 26, as amended herein, are clearly and patentably distinguished over Tong and are, therefore, allowable. As claims 4-9, 19, 21, 27-29, and 35 depend, directly or indirectly, from claims 1, 20, or 26, Applicant submits that these claims are allowable as well.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 4-9, 19-21, 26-29, and 35 under 35 U.S.C. § 102(b) as being anticipated by Tong.

4. Claims 26 and 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Trolle (U.S. Pat. No. 1,141,889). Applicant respectfully traverses this rejection as applied to the claims as amended.

Trolle discloses an exterior, metal “bottom” (i.e., sole) for shoes and boots. Col. 1, ll. 34-47. A shoe incorporating the Trolle metal sole A purportedly withstands rough usage and provides protection against a number of undesirable elements. Col. 1, l. 52 – col. 2, l. 1. Clearly, though, a shoe with a metal sole would be uncomfortable for the wearer and difficult in which to walk, particular on slippery surfaces. Col. 3, ll. 35-38. Accordingly, Trolle includes a plurality of flexible, ground engaging surfaces C, D under the heel and ball of the foot that apparently increase comfort and stability. *Id.*; col. 2, ll. 57-69. As shown in Trolle Figure 2, the metal sole A is raised above the ground by the ground engaging surfaces C, D.

Applicant’s invention is nonobvious, because the Trolle metal sole A addresses a problem that is different from that addressed by Applicant’s chassis. An invention is nonobvious if the elements cited in the prior art typically deal with different problems. *See, e.g., Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984). The Trolle metal sole A is concerned with the problem of protecting the feet of the wearer from harsh conditions, while Applicant’s chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 2, ll. 1-2. Further, Applicant’s chassis is not part of a shoe exterior, but is integrated (e.g., molded) into the shoe outsole or interposed between (i) the outsole and midsole, or (ii) the midsole and insole. Specification, p. 5, l. 25 – p. 6, l. 1. In light of these differences, a person of ordinary skill, on reading Trolle, would be discouraged from following the path set out in Trolle, or would be led in a direction divergent from the path that Applicant took. *See, e.g., In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Accordingly, Applicant respectfully submits that independent claim 26 is clearly and patentably distinguished over the cited reference and is therefore allowable. Because claims 29-31 depend, directly or indirectly, from claim 26, Applicant submits that these claims are allowable as well.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 26 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Trolle.

5. Claims 1, 4, 6-10, and 19-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lorenzi et al. (U.S. Pat. No. 1,684,676). Applicant respectfully traverses this rejection as applied to the claims as amended.

Lorenzi et al. discloses a metal stiffening plate 4 that is mounted on the upper side of the rubber sole and heel section of a shoe. Col. 2, ll. 89-92. The metal stiffening plate 4 includes a tongue 5 that extends from a cross piece 6 into the forefoot region of the shoe. Lorenzi et al., Figure 1; col. 3, ll. 22-26. The metal stiffening plate 4 also extends about the periphery of the shoe to include a plurality of openings 9. Figure 1; col. 2, ll. 98-100.

Applicant's invention is nonobvious, because the Lorenzi et al. metal stiffening plate 4 addresses a problem that is different from that addressed by Applicant's chassis. An invention is nonobvious if the elements cited in the prior art typically deal with different problems. *See, e.g., Lindemann Maschinenfabrik GmbH*, 221 USPQ 481. The Lorenzi et al. metal stiffening plate 4 "serves to prevent the upturning or curling of the toe portions of the sole of the boot and serves as an effective anchorage for calks." Col. 4, ll. 65-70. As discussed above, Applicant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 2, ll. 1-2. Applicant's claimed chassis is also generally planar, which is distinguishable from the clearly non-planar, stepped nature of the metal stiffening plate 4 depicted in Lorenzi et al. Figure 2. Lastly, Lorenzi et al. does not include Applicant's claimed plurality of elongated elements. Rather, the Lorenzi et al. metal stiffening plate 4 includes a single element (the tongue 5) and a continuous, circumferential portion that follows the periphery of the shoe. This latter portion is clearly distinguishable from the independent elongated elements Applicant claims and depicts in, for example, Figures 1A, 2A, 3A, and 4. In light of these differences, a person of ordinary skill, on reading Lorenzi et al., would be discouraged from following the path set out in Lorenzi et al., or would be led in a direction divergent from the path that Applicant took. *See, e.g., In re Gurley*, 31 USPQ 2d at 1131.

Accordingly, Applicant respectfully submits that independent claims 1, 20, and 26 are clearly and patentably distinguished over the cited reference and are therefore allowable.

Because claims 4, 6-10, 19, 21-25, and 27-29 depend, directly or indirectly, from claims 1, 20, or 26, Applicant submits that these claims are allowable as well.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 4, 6-10, and 19-29 under 35 U.S.C. § 103(a) as being unpatentable over Lorenzi et al.

6. Claims 1, 5, 6, 8-10, 12-23, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917). Applicant respectfully traverses this rejection as applied to the claims as amended.

Giese discloses a composite shoe bottom with a lower layer 2, an upper layer 3, and stabilizer 19 molded therebetween above the lower layer 2. Col. 11, l. 67 – col. 12, l. 3; Figures 111 – 116. The stabilizer 19 includes stabilizer arms 29 that are confined to the area about the ball of the foot and that do not extend into the forefoot area. Col. 12, ll. 7-10; Figure 111.

As discussed above, Tong discloses an insert member 120 for a sole 24. As shown in Tong Figure 17, the extending portion 124 of the insert member 120 has “an undulating or sinusoidal shape in cross section.” Col. 9, ll. 27-29. Tong Figures 16 and 17 clearly show that the extending portion 124 corresponds to the forefoot area.

Brown is a design patent that discloses a sole insert for a shoe. The Brown insert is depicted in isolation without, for example, the benefit of one or more phantom lines that would show its location in a shoe. Consequently, the size, location, and extent of the Brown insert relative to a shoe in which it is installed are unknown.

Applicant’s invention is nonobvious, because the combination of Giese with Tong or Brown fails to show or suggest the claimed invention. As the Office Action indicates, the Giese stabilizer arms 29 do not extend through the entire forefoot area. Office Action, p. 4. Combining Giese with Tong would result in a structure that has an “undulating or sinusoidal” shape, in contrast to Applicant’s claimed generally planar chassis. Further, Applicant respectfully disagrees with the statement in the Office Action that Brown Figure 2 teaches extending forefoot elongated elements through the entire forefoot area. Office Action, p. 4. As stated above, the Brown design patent fails to disclose the extent of the insert relative to the shoe

in which the insert is installed. As depicted in Brown Figures 1-5, the extent of the purported forefoot area of the Brown insert is undefined. Consequently, Brown cannot be said to teach any particular extent of the forefoot elongated elements, so combining Giese with Brown fails to suggest any modification of the extent of the Giese stabilizer arms 29 that would arrive at Applicant's claimed invention.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 5, 6, 8-10, 12-23, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Giese in view of Tong or Brown.

7. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Kendall (U.S. Pat. No. 5,713,143). Applicant respectfully submits that Kendall fails to cure the deficiencies of Giese, Tong and Brown with respect to independent claim 1. Because claim 11 indirectly depends from claim 1, Applicant respectfully submits that claim 11 is clearly and patentably distinguished over the cited references, either alone or in combination, and is therefore allowable.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Giese in view of Tong or Brown, further in view of Kendall.

8. Claims 26-30 and 35-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Crowley (U.S. Pat. No. 4,393,604). Applicant respectfully traverses this rejection as applied to the claims as amended.

Applicant respectfully reiterates his position that the combination of Giese with either Tong or Brown fails to show or suggest the claimed invention. As discussed in detail above, the combination of Giese with Tong would result in a structure that has an "undulating or sinusoidal" shape, in contrast to Applicant's claimed generally planar chassis. Further, the lack of any disclosure in Brown relative to the extent of the insert does not, when combined with Giese, suggest any modification of the Giese stabilizer arms 29. Accordingly, Applicant respectfully

submits that Crowley fails to cure the deficiencies of Giese, Tong and Brown with respect to independent claim 26. Because claims 27-30 and 35-38 depend, directly or indirectly, from claim 26, Applicant respectfully submits that these claims are clearly and patentably distinguished over the cited references, either alone or in combination, and are therefore allowable.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 26-30 and 35-38 under 35 U.S.C. § 103(a) as being unpatentable over Giese in view of Tong or Brown, further in view of Crowley.

9. Lastly, claims 30 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Giese (U.S. Pat. No. 5,572,805) in view of Tong (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917), further in view of Crowley (U.S. Pat. No. 4,393,604), and further in view of Cameron (U.S. Pat. No. 3,739,497) or Barre (U.S. Pat. No. 5,473,827). Applicant respectfully submits that Cameron and Barre fail to cure the deficiencies of Giese, Tong, Brown, and Crowley with respect to independent claim 26 as discussed above in section 8. Because claims 30 and 31 depend from claim 26, Applicant respectfully submits that claims 30 and 31 are clearly and patentably distinguished over the cited references, either alone or in proper combination, and are therefore allowable.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Giese in view of Tong or Brown, further in view of Crowley, and further in view of Cameron or Barre.

CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 4-23, 26-31, and 35-39 are clearly and patentably distinguished over the cited references, either alone or in proper combination, and are therefore allowable. Applicant respectfully requests entry of this Amendment and Response, reconsideration, and early favorable action by the Examiner.

The Examiner is cordially invited to contact Applicant's undersigned representative at the number listed below to discuss any outstanding issues.

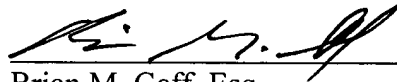
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VERSION OF AMENDED ITEMS WITH MARKINGS TO SHOW CHANGES MADE

January 7, 2003

IN THE CLAIMS:

26. (Four Times Amended) An article of footwear including a sole with at least one cleat, the sole comprising a generally planar polymeric chassis, wherein a forefoot portion of the chassis has a lateral side and a medial side, the lateral and medial sides being proximate to corresponding lateral and medial sides of the article of footwear, the chassis extending substantially along an entire length of (i) a heel portion of the article of footwear, and (ii) a toe portion of the article of footwear, and wherein the cleat is proximate to at least one of the lateral and medial sides of the article of footwear.

39. (Twice Amended) A generally planar polymeric chassis for installation in an article of footwear, the chassis comprising at least three elongated elements with generally nonlinear spaces formed therebetween. the elongated elements ~~that~~ extending from a lateral side to a medial side of the chassis and extending substantially along an entire length of the chassis from a heel portion of the chassis to a toe portion of the chassis, each elongated element comprising:

a midfoot portion;

a forefoot portion; and

a rearfoot portion.

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